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In re Application of :
Gratzl, et al. :
Application No.: 09/980,089 : DECISION ON
PCT No.: PCT/US00/14805 :
Int. Filing Date: 30 May 2000 : PETITION
Priority Date: 28 May 1999 :
Attorney's Docket No.: CWR 2 0282 : UNDER 37 CFR 1.47(a)
For: DEVICES AND METHODS FOR ASSESSING :
CELLULAR TRANSPORT FOR RESEARCH, DRUG :
DISCOVERY AND TESTING, CLINICAL DIAGNOSES :
AND THERAPY DESIGN :

This is a decision in response to the "PETITION TO ACCEPT SIGNATURE OF PROPRIETARY INTEREST HOLDER ON BEHALF OF NON-SIGNING INVENTORS UNDER 37 CFR § 1.47(b)" filed on 12 August 2002 to accept the application without the signatures of inventors Takashi Matsumoto, Chen Yi, Gary R. Bright and Rohit Kashyap.

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BACKGROUND

On 30 May 2000, applicants filed international application PCT/US00/14805 that claimed priority of an earlier United States provisional application filed 28 May 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 07 December 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 09 November 2000 prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 28 November 2001.

On 28 November 2001, applicants filed a letter for entry into the national stage in the United States which was accompanied by a preliminary amendment and the basic national fee of \$355 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/980,089.

On 11 February 2002, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicants were required to file an oath/declaration and a surcharge fee. The notification set a two-month time period in which to respond.

On 12 August 2002, applicants filed a "PETITION TO ACCEPT SIGNATURE OF PROPRIETARY INTEREST HOLDER ON BEHALF OF NON-SIGNING INVENTORS UNDER 37 CFR § 1.47(b).

In order to satisfy the requirements of 35 U.S.C. 371(c)(4), on 12 August 2002, applicants filed the following papers:

- 1) a Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) including a Petition under 37 CFR 1.47(a);
- 2) the \$65 surcharge for providing the oath/declaration after 30 months from the earliest priority date;
- 3) a declaration executed by Miklos Gratzl and Hongwen Lu on behalf of Takashi Matsumoto, Chen Yi, Gary R. Bright and Rohit Kashyap,
- 4) an affidavit signed by Catherine A. Porto, Associate Vice-President of Technology transfer at Case Western University giving inventors Takashi Matsumoto, Chen Yi, Gary R. Bright and Rohit Kashyap last known addresses.

DISCUSSION

Since at least one inventor has signed the declaration, the application cannot be made under 37 CFR 1.47(b). Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

With respect to item (1), applicants' deposit account (06-0308) has been charged the \$130 petition fee. With respect to item (3), applicants have provided the last known addresses of the non-signing inventors. With respect to item (4), applicants have

provided a declaration executed by Miklos Gratzl and Hongwen Lu on behalf of Takashi Matsumoto, Chen Yi, Gary R. Bright and Rohit Kashyap,

MPEP §409.03(b) states, in part:

“Where inability to find or reach a nonsigning inventor “after diligent effort” is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.”

With respect to item (2) above, there is no indication in Ms. Porto's statements that a delivery of the application papers was ever attempted. Although Ms. Porto states that diligent efforts were made to reach the non-signing inventors, Ms. Porto has not offered any evidence to corroborate this statement. Further, Ms. Porto's statement that attempts were made through outside patent counsel is a statement based on hearsay which is unacceptable.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

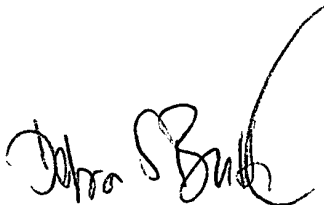
Applicants' **Deposit Account # 06-0308** has been **charged** the **\$130** petition fee.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47(a).” No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).


Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as becoming abandoned with respect to the United State at midnight at the expiration of the time period set in this decision or as extended by any extension see timely paid under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.

Applicant is advised that, effective May 1, 2003, the Office is changing its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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